

REMARKS

The Examiner is thanked for the thorough examination of the present application. The Office Action, however, has tentatively rejected claims 1-14.

The Office Action rejected claims 1-14 under 35 U.S.C. § 112, second paragraph, as allegedly indefinite. Applicant has amended independent claims 1, 5, and 10 to address and overcome this rejection.

The Office Action also rejected claims 1-14 under 35 U.S.C. § 103 as allegedly obvious over the combination of AAPA (Fig. 2) in view of U.S. patent 6,486,818 to Nicholson. Applicants respectfully request reconsideration and withdrawal of these rejections for at least the reasons set forth below.

First, each of the independent claims 1, 5, and 10 have been amended to recite an equivalent resistor "according to a selection code ... wherein the selection code is corresponding to a designated filtering bandwidth of the AFE device." This feature is wholly lacking from either AAPA or the cited Nicholson reference. Thus, even if properly combined, the AAPA and Nicholson fail to teach all of the claimed features of Applicants' claimed invention, and the rejection should be withdrawn for at least this reason.

As a separate and independent basis for the patentability of claims 1-14, Applicants respectfully traverse the rejections as failing to identify a proper basis for combining the Nicholson with AAPA. In combining these references, the Office Action stated only that the combination would have been obvious "simply to allow variability of the resistor (it is old and well-known in the art that it is advantageous to have a variable as opposed to a fixed resistor)."

(Office Action, last three lines of page 3). This alleged motivation is clearly improper in view of well-established Federal Circuit precedent.

It is well-settled law that in order to properly support an obviousness rejection under 35 U.S.C. § 103, there must have been some teaching in the prior art to suggest to one skilled in the art that the claimed invention would have been obvious. W. L. Gore & Associates, Inc. v. Garlock Thomas, Inc., 721 F.2d 1540, 1551 (Fed. Cir. 1983). More significantly,

"The consistent criteria for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this [invention] should be carried out and would have a reasonable likelihood of success, viewed in light of the prior art. ..." Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure... In determining whether such a suggestion can fairly be gleaned from the prior art, the full field of the invention must be considered; for the person of ordinary skill in the art is charged with knowledge of the entire body of technological literature, including that which might lead away from the claimed invention."

(*Emphasis added.*) In re Dow Chemical Company, 837 F.2d 469, 473 (Fed. Cir. 1988).

In this regard, Applicants note that there must not only be a suggestion to combine the functional or operational aspects of the combined references, but that the Federal Circuit also requires the prior art to suggest both the combination of elements and the structure resulting from the combination. Stiftung v. Renishaw PLC, 945 Fed.2d 1173 (Fed. Cir. 1991). Therefore, in order to sustain an obviousness rejection based upon a combination of any two or more prior art references, the prior art must properly suggest the desirability of combining the particular elements to derive an AFE device, as claimed by the Applicants.

When an obviousness determination is based on multiple prior art references, there must be a showing of some "teaching, suggestion, or reason" to combine the references. Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir.

1997) (also noting that the “absence of such a suggestion to combine is dispositive in an obviousness determination”).

Evidence of a suggestion, teaching, or motivation to combine prior art references may flow, inter alia, from the references themselves, the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved. See In re Dembiczak, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be “clear and particular.” Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617.

If there was no motivation or suggestion to combine selective teachings from multiple prior art references, one of ordinary skill in the art would not have viewed the present invention as obvious. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); Gambro Lundia AB, 110 F.3d at 1579, 42 USPQ2d at 1383 (“The absence of such a suggestion to combine is dispositive in an obviousness determination.”).

Significantly, where there is no apparent disadvantage present in a particular prior art reference, then generally there can be no motivation to combine the teaching of another reference with the particular prior art reference. Winner Int’l Royalty Corp. v. Wang, No 98-1553 (Fed. Cir. January 27, 2000).

For at least the additional reason that the Office Action failed to identify proper motivations or suggestions for combining the various references to properly support the rejections under 35 U.S.C. § 103, those rejections should be withdrawn.

New claims 28-32 depend from either claim 1, 5, or 10, and patently define over the cited art for at least the same reasons as those claims.

In view of the amendments, Applicants respectfully submit that all pending claim 1-14 and 28-32 are in condition for allowance.


Should the Examiner believe that a teleconference would expedite the examination of this application, then the Examiner is invited to contact the undersigned attorney.

No fee is believed to be due in connection with this amendment and response to Office Action. If, however, any fee is believed to be due, you are hereby authorized to charge any such fee to deposit account No. 20-0778.

Respectfully Submitted,

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